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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/409,617	10/01/1999	DAVID MICHAEL SHACKELFORD	TU9-99-029	5644
46917	7590	07/06/2005	EXAMINER	
KONRAD RAYNES & VICTOR, LLP. ATTN: IBM37 315 SOUTH BEVERLY DRIVE, SUITE 210 BEVERLY HILLS, CA 90212			LANIER, BENJAMIN E	
			ART UNIT	PAPER NUMBER
			2132	

DATE MAILED: 07/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/409,617

Applicant(s)

SHACKELFORD, DAVID MICHAEL

Examiner

Benjamin E Lanier

Art Unit

2132

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 May 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 October 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

RP

DETAILED ACTION

Response to Amendment

1. Applicant's amendment filed 24 May 2005 amends claims 1, 9, 11, 16, 22, 24, 27, 30, 35, 37. Applicant's amendment has been fully considered and is entered.

Response to Arguments

2. Applicant's arguments filed 24 May 2005 have been fully considered but they are not persuasive. Applicant's arguments on pages 13-17 of the remarks are not persuasive because one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).
3. Applicant's argument that Ananda does not disclose the central facility determining whether the user can access software, but rather discloses whether the user may continue access to the software is not persuasive because determining access, whether it is continued or initial, meets the limitations as currently claimed.
4. Applicant's argument that Ananda does not disclose that the central facility compare a message in an encrypted response from the user computer to determine whether it matches the generated message the central facility previously sent to the user computer is not persuasive because the central server then generates an encrypted message and sends it to the user (Ananda, Col. 11, lines 45-60), which meets the limitation of generating an encrypted message and transmitting it. The user receives and decrypts the message and sends an encrypted response to the central server (Ananda, Col. 12, lines 15-34), which meets the limitation of receiving an encrypted response from the second computer system. The central server receives the encrypted

Art Unit: 2132

message and decrypts it. The central server then compares the message using a password correlation algorithm against the stored information regarding the user processor clock time (random component, time stamp), the user identification password, and the authorization verification password (Ananda, Col. 12, lines 36-46), which meets the limitation of determining whether there is a code made available by the second computer system capable of encrypting the received encrypted response, decrypting the encrypted response with the determined code if there is one determined code, and processing the decrypted response to determine whether the second computer system is authorized to access the software.

5. Applicant's argument that prior art does not disclose the second computer providing a key to the first computer, and then transmitting a response to the first computer that can be decrypted by the send key at the distributor computer, and the receiving access to the requested software in response to the encrypted response message is not persuasive because one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

6. Applicant's argument that the prior art does not disclose a message generated and encrypted and sent to a second computer system which is then included in an encrypted response by the second computer system to the first computer system, comprises a time stamp is not persuasive because Ananda does not disclose using time stamps as an offset in the transmitted messages. Komura discloses a packet transmission system wherein time stamp offset values are attached to data packets (message)(Col. 7, lines 22-30). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use time stamp offset values in the

Art Unit: 2132

system for secure software rental for synchronizing purposes taught in Komura (Col. 6, lines 40-67).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 1-4, 7-30, 33-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ananda, U.S. Patent No. 5,495,411, in view of Takahashi, U.S. Patent No. 6,195,432. Referring to claims 1-4, 8, 12, 13, 15-19, 21, 25, 27-30, 34, 38, 39, Ananda discloses a secure software rental system wherein a user requests software from a central server. The central server then generates an encrypted message and sends it to the user (Col. 11, lines 45-60), which meets the limitation of generating an encrypted message and transmitting it. The user receives and decrypts the message and sends an encrypted response to the central server (Col. 12, lines 15-34), which meets the limitation of receiving an encrypted response from the second computer system. The central server receives the encrypted message and decrypts it. The central server then compares

Art Unit: 2132

the message using a password correlation algorithm against the stored information regarding the user processor clock time (random component, time stamp), the user identification password, and the authorization verification password (Col. 12, lines 36-46), which meets the limitation of determining whether there is a code made available by the second computer system capable of encrypting the received encrypted response, decrypting the encrypted response with the determined code if there is one determined code, and processing the decrypted response to determine whether the second computer system is authorized to access the software. Once authorized the user is able to receive the application software (Col. 12, lines 47-53), which meets the limitation of permitting the second computer system access to the software after determining that the second computer system is authorized to access the software. Ananda does not disclose that the key used for decryption is made available by the second computer. Takahashi discloses a software distribution system wherein a shared key is generated at a user computer and is transmitted to the software store (Col. 2, lines 10-25) at registration time (Col. 5, lines 32-36). Takahashi also discloses that store side contains a user information storage unit that stores a user ID, a shared key, a credit card number, and private information (Col. 10, lines 64-66). The private information is auxiliary information related to that customer (Col. 11, lines 22-24). The auxiliary information includes a number unique to a computer owned by a user (Col. 6, lines 61-66). The store side does not store the user information, which includes the shared key, unless the user is authorized to use the software (Col. 10, lines 47-53), which meets the limitation of maintaining keys of computer systems authorized to access software to be distributed. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the registration process of Ananda to include the delivery of a cryptographic key to the software

Art Unit: 2132

server in order to establish encrypted communication between the server and the user as taught in Takahashi (Col. 2, line 12).

Referring to claims 9, 14, 22, 26, 35, Takahashi discloses the use of public key cryptography in the method for transfer of payment information between the software store and the user (Col. 2, lines 4-67). It would have been obvious to one of ordinary skill in the art at the time the invention was made for the software rental system of Ananda to use public key encryption during the transfer of payment information in order to enable electronic purchase of software without a danger of having a credit card number stolen as taught in Takahashi (Col. 3, lines 21-24).

Referring to claims 10, 11, 23, 24, 36, 37, 40, Ananda discloses that the response contains the user processor clock (configuration data) (Col. 12, lines 20-25).

Referring to claims 7, 20, 33, Takahashi discloses a method for installation of the received software offered through the network (Col. 4, lines 32-35), which meets the limitation of automatically causing the installation of the computer software on the second computer system when the computer software is transmitted to the second computer system. It would have been obvious to one of ordinary skill in the art to automatically install the transmitted software in Ananda in order to assist users who are not accustomed to handle a personal computer as taught in Takahashi (Col. 3, lines 57-64).

10. Claims 5, 6, 31, 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ananda, U.S. Patent No. 5,495,411, in view of Takahashi, U.S. Patent No. 6,195,432 as applied to claims 1, 4, 27, 30 above, and further in view of Komura, U.S. Patent No. 5,994,307.

Referring to claims 5, 6, 31, 32, Ananda discloses a secure software rental system wherein a user

Art Unit: 2132

requests software from a central server. The central server then generates an encrypted message and sends it to the user (Col. 11, lines 45-60), which meets the limitation of generating an encrypted message and transmitting it. The user receives and decrypts the message and sends an encrypted response to the central server (Col. 12, lines 15-34), which meets the limitation of receiving an encrypted response from the second computer system. The central server receives the encrypted message and decrypts it. The central server then compares the message using a password correlation algorithm against the stored information regarding the user processor clock time (random component, time stamp), the user identification password, and the authorization verification password (Col. 12, lines 36-46), which meets the limitation of determining whether there is a code made available by the second computer system capable of encrypting the received encrypted response, decrypting the encrypted response with the determined code if there is one determined code, and processing the decrypted response to determine whether the second computer system is authorized to access the software. Once authorized the user is able to receive the application software (Col. 12, lines 47-53), which meets the limitation of permitting the second computer system access to the software after determining that the second computer system is authorized to access the software. Takahashi discloses a software distribution system wherein a shared key is generated at a user computer and is transmitted to the software store (Col. 2, lines 10-25) at registration time (Col. 5, lines 32-36). Takahashi also discloses that the store side contains a user information storage unit that stores a user ID, a shared key, a credit card number, and private information (Col. 10, lines 64-66). The private information is auxiliary information related to that customer (Col. 11, lines 22-24). The auxiliary information includes a number unique to a computer owned by a user (Col. 6, lines 61-66). The store side does not store

Art Unit: 2132

the user information, which includes the shared key, unless the user is authorized to use the software (Col. 10, lines 47-53), which meets the limitation of maintaining keys of computer systems authorized to access software to be distributed. Ananda does not disclose using time stamps as an offset in the transmitted messages. Komura discloses a packet transmission system wherein time stamp offset values are attached to data packets (message)(Col. 7, lines 22-30). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use time stamp offset values in the system for secure software rental for synchronizing purposes taught in Komura (Col. 6, lines 40-67).

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin E. Lanier whose telephone number is 571-272-3805. The examiner can normally be reached on M-Th 7:30am-5:00pm, F 7:30am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

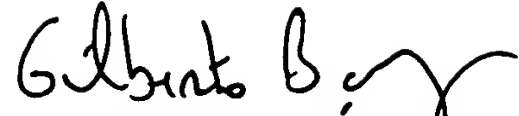
Application/Control Number: 09/409,617

Page 9

Art Unit: 2132



Benjamin E. Lanier



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